

## **REMARKS**

The above amendments and the following remarks are fully and completely responsive to the Office Action dated August 16, 2004. Claims 1-10 are pending in this application. By this Amendment, claims 1, 4, 5 and 8 have been amended. No new matter has been added. In the outstanding Office Action, claims 1-10 were rejected under 35 U.S.C. § 103(a). Claims 1-10 are presented for consideration.

### **35 U.S.C. § 103(a)**

Claims 1-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumi et al. (U.S. Patent No. 6,711,343, "Matsumi") in view of Fujinami et al. (U.S. Patent No. 6,385,152, "Fujinami").

In making this rejection, the Office Action asserts that the combination of these two references teaches each and every element of the claimed invention. The Office Action also asserts that it would be obvious to one of ordinary skill in the art to combine these two references. Applicants disagree and respectfully request reconsideration of this rejection.

Claim 1 recites in part:

control means for, when said program information is recorded into said first recording unit, (a) obtaining management information for managing said program information recorded in the information recording medium or supplied via the communication network, (b) in case that the title information corresponding to said program information is obtained by searching through said second recording unit based on the management information obtained, appending the title information obtained to said program information so as to be recorded into said first recording unit, and (c) in case that the title information corresponding to said program information is not obtained by searching through said second

recording unit based on the management information obtained, appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit.

Accordingly, the information recording/reproducing apparatus of the present invention searches the title information pre-recorded in the second recording unit when program information reproduced from an information recording medium or supplied through a communication network is recorded into the first recording unit. When the title information corresponding to the program information is found, the title information is appended to the program information so as to be recorded into the first recording unit. If the corresponding title information is not found, the information indicating the absence of the title information is appended to the program information so as to be recorded in the first recording unit. Consequently, it is possible to distinguish the program information that does not have the title information appended from program information that has title information appended. Therefore, the user is provided with information in an easy-to-handle form.

This claim element is a means-plus-function claim element under 35 U.S.C. § 112, sixth paragraph. In order to anticipate a means-plus-function claim, a reference must disclose the exact function recited in the claim. If the reference discloses the exact function, then a comparison is made between the structure disclosed in the Specification and the structure disclosed in the reference. Since neither Matsumi nor Fujinami disclose each recited function, a comparison of the structure disclosed in the reference to the structure disclosed in the Specification is not required.

Matsumi's control means performs the function of validating the operation signal output from the operation means and disregarding a command signal when receiving an operation means valid signal. This control means invalidates the operation signal output from the operation means and uses the command signal when receiving an operation means invalid signal. See column 48, lines 24-30.

The Office Action asserts that Matsumi, at column 27, lines 17-26, teaches the recited second recording unit. This section of Matsumi states:

FIG. 12(a) first shows a condition wherein file system information A is recorded in data having already been recorded, and information (title end) indicating the end position of a program indicates the position wherein data recording is ended. After this recording, if additional recording is carried out by a conventional apparatus not conforming to the file system information in accordance with the present embodiment, the file system information A is not recognized as shown in FIG. 12(b), data is recorded from the information (title end) indicating the end position of the program, the file system information A is deleted completely, and filed data having already been recorded becomes an unfiled condition. As shown in FIG. 12(c), by recording file system information B having the data having already been recorded and the append-recorded data, a normal condition can be restored. In this case, file system information is required to be re-created by carrying out filing again; however no trouble is caused.

(Col. 27, lines 17-34)

As clearly shown in FIGs. 12(a)-12(c), the data is written on the tape prior to the writing or recording of file system information A. As also shown in FIGs. 12(a)-12(c), it appears that either file system information A or file system information B is appended to the end of the data. Consequently, either the file system information A or the file system information B **must** be recorded on the tape after the data or the append-recorded data.

In contrast, claim 1 recites “a second recording unit, provided in said recording device, for recording title information corresponding to said program information prior to recording said program information”. Consequently, neither the file system information A nor the file system information B can be the recited second recording unit since both the file system information A and the file system information B are recorded after the program data is recorded.

The Office Action asserts that Matsumi, at column 25, lines 6-10 and column 27, lines 30-34, teaches the function of searching through the second recording unit based on the management information returned or obtained and, in the case that the title information corresponding to the program information is obtained, appending the title information obtained to the program information so as to be recorded into the first recording unit. Matsumi, at column 25, lines 4-10, teaches:

By recording file system information on the additional recording medium 113 in this way, after this cassette is ejected once, and reproduction is attempted again, it is possible to easily search the file system information on the recording medium (tape) 110 (or it is not necessary to carry out search); therefore, it is possible to quickly confirm the contents of the cassette.

Thus, Matsumi teaches searching the file system information A or B. However, as shown in FIGs. 6, 7, 12(c), 16(b) and 17, the title information found in the search is not appended to the program information. Matsumi only discloses appending a valid file system information after the last program or data file is recorded. Nowhere in Matsumi is it disclosed that title information is appended to each individual data file.

Similarly, Matsumi fails to teach appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit.

Accordingly, Matsumi fails to disclose the function of appending the title information obtained to said program information so as to be recorded into said first recording unit in the case that the title information corresponding to said program information is obtained by searching through said second recording unit based on management information obtained. Similarly, Matsumi fails to disclose the function of appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit in the case that the title information corresponding to said program information is not obtained by searching through said second recording unit based on the management information obtained. Consequently, Matsumi fails to teach and/or suggest the “control means for, when said program information is recorded into said first recording unit, ... (b) in case that the title information corresponding to said program information is obtained by searching through said second recording unit based on the management information obtained, appending the title information obtained to said program information so as to be recorded into said first recording unit, and (c) in case that the title information corresponding to said program information is not obtained by searching through said second recording unit based on the management information obtained, appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit.”

The Office Action admitted that Matsumi does not explicitly indicate the claimed “communication network”. The Office Action cites Fujinami as correcting this deficiency in Matsumi. Fujinami, however, is not cited for, nor does it correct, the deficiency discussed above in Matsumi. Accordingly, the combination of Matsumi and Fujinami fails to teach and/or suggest the claimed invention.

Specifically, the combination of these two references fails to disclose the function of appending the title information obtained to said program information so as to be recorded into said first recording unit. Similarly, the combination of these two references fails to teach the function of appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit. Therefore, the combination of these two references fails to teach and/or suggest a “control means for, ... (b) in case that the title information corresponding to said program information is obtained by searching through said second recording unit based on the management information obtained, appending the title information obtained to said program information so as to be recorded into said first recording unit, and (c) in case that the title information corresponding to said program information is not obtained by searching through said second recording unit based on the management information obtained, appending information indicating an absence of the title information to said program information so as to be recorded into said first recording unit.” Therefore, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-10 under 35 U.S.C. § 103(a).

## **Conclusion**

Applicants' remarks have overcome the rejection set forth in the Office Action dated August 16, 2004. Applicants' remarks have distinguished claims 1-10 from the combination of Matsumi and Fujinami and thus overcome the rejection of these claims under 35 U.S.C. § 103(a). Accordingly, claims 1-10 are in condition for allowance. Therefore, Applicants respectfully request consideration and allowance of claims 1-10.

Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney by telephone if it is believed that such contact will expedite the prosecution of the application.

In the event that this paper is not considered to be timely filed, Applicants respectfully petition for an appropriate extension of time.

Please charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referring to client/matter number 107156-00094.

Respectfully submitted,  
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Enclosures: Petition for Extension of Time  
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